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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,134	01/25/2001	Spencer A. Rathus	660-015	8417

7590 08/13/2003
Ward & Olivo
382 Springfield Avenue
Summit, NJ 07901

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,134

Applicant(s)

RATHUS ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/07/03 (Amendment & TD).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 168-261 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 168-261 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on April 7, 2003. In the amendment,
5 claims 256 and 259 were amended. Currently, claims 168-261 remain for examination.

Terminal Disclaimer

2. The terminal disclaimer filed on April 18, 2003 disclaiming the terminal portion of any
patent granted on this application, which would extend beyond the expiration date of US Patent
10 No. 5,932,863 to Rathus et al. has been reviewed and is accepted. The terminal disclaimer has
been recorded (paper #10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
15 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
20 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
25 evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256, and 258-261 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al. (US 4,488,035, "Withnall" hereinafter) in view of Fields (US 4,481,412) and Tannehill et al. (US 5,158,310, "Tannehill" hereinafter).

Re claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256, and 258-261: Withnall discloses a system for displaying information to a user comprising a printed travel ticket (e.g., train, bus, etc.) having at least one machine recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the information on the portable handset illuminated display having a microprocessor with programmable memories (col. 5, lines 10-17).

Withnall fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal.

Fields teaches the above limitation with an accessing means 10 having a microcontroller 23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for transmitting/accessing the programming material in response to receiving the coded signal (fig. 2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a

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video/image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall in order to provide Withnall with a higher technology system wherein the user being provided with complete information in flexible ways (i.e., video, pictorial, etc.). Furthermore, such modification would have been an obvious extension as taught by Withnall, and therefore an obvious expedient.

Withnall as modified by Fields have been discussed above but fails to teach or fairly suggest that the system comprises a printed advertisement and at least one machine recognizable feature comprises a magnetic code/strip.

Tannehill teaches the above limitation with printed advertisement (figs. 2, 8-9, 11 a & 12) and the machine recognizable feature can be a barcode or a magnetic strip (col. 18, lines 712).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill into the teachings of Withnall/Fields in order to provide the consumer with a convenient way of saving money by displaying an advertising program, which attracts people to shop. Such advertisement can lead to increasing number of customers and to generating increased revenues. In view of the above, retailers or business owners would be motivated to incorporate user-friendly advertisement system. Furthermore, such modification would provide Withnall/Fields with an alternative feature for encoding data (i.e., barcode or magnetic strip). Accordingly, such modification would

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have mere been a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

4. Claims 174, 175, 180, 181, 183, 185, 189, 190, 192, 193, and 214-219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill as applied to claim 168 and 301 above, and further in view of Roberts (US 5,324,922) and Malec et al (US 5,287,266, "Malec" hereinafter). The teachings of Withnall as modified by Fields and Tannehill have been discussed above.

Re claims 174, 175, 180, 181, 183, 185, 189, 190, 192, 193, and 214-219:

Withnall/Fields/Tannehill have been discussed above but fails to teach or fairly suggest feature for online/home shopping and the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of

Withnall/Fields/Tannehill with the latest technology for a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Tannehill to provide the user an alternative way of doing shopping (i.e., shopping online/at home), and therefore an obvious expedient.

Withnall/Fields/Tannehill as modified by Roberts fails to teach or fairly suggest that the data link comprises an ISDN line.

Malec teaches the above limitation with the use of ISDN technology (col. 7, lines 112).

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It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec into the teachings of Withnall/Fields/Tannehill/Roberts in order to provide Withnall/Fields/Tannehill/Roberts with the latest technology for a more accurate and faster system due to the benefit of ISDN networking lines. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Tannehill/Roberts and would have merely been a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

5 Claims 179, 182, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221-226, 234, 239,
10 241-243, 254, and 257 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill as applied to claim 168 and 301 above, and further in view of Bravman et al (US 5,401,944, "Bravman" hereinafter). The teachings of Withnall as modified by Fields and Tannehill have been discussed above.

Re claims 179, 182, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221-226, 234,
15 239, 241-243, 254, and 257: Withnall/Fields/Tannehill have been discussed above but fails to teach or fairly suggest that the displayed information including specific details related to traveling (e.g., seat location, departure terminal, hotel, restaurant, etc.), wherein the display unit comprising a wireless communication device (e.g., a remote unit).

Bravman teaches the above limitation with remote units 15 providing all necessary
20 information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through col. 14, line 5 and col. 16, line 14 through col. 18, line 22.

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It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman into the teachings of Withnall/Fields/Tannehill in order to provide Withnall/Fields/Tannehill with a more flexible system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Tannehill, and therefore an obvious expedient.

6. Claims 197, 202, and 205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill as applied to claim 168 and 301 above, and further in view of Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields and Tannehill have been discussed above.

Re claims 197, 202, and 205, Withnall/Fields/Tannehill have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields/Tannehill in order to provide Withnall/Fields/Tannehill with a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus preventing manipulating by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall an obvious expedient.

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7. Claims 206-208 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill as applied to claim 168 and 301 above, and further in view of Schach et al (US 5,397,156, "Schach" hereinafter) and Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields and Tannehill have been discussed above.

5 Re claims 206-208 and 211, Withnall/Fields/Tannehill have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a watermark.

Schach teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

10 It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schach into the teachings of Withnall/Fields/Tannehill aesthetic purpose. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Tannehill, and therefore an obvious expedient.

Withnall/Fields/Tannehill as modified by Schach fails to teach or fairly suggest that at
15 least one machine recognizable feature comprises an invisible watermark.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of
20 Withnall/Fields/Tannehill/Schach in order to provide Withnall/Fields/Tannehill/Schach with a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus preventing manipulating by a fraudulent user. Furthermore, such

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modification would have been an obvious extension as taught by

Withnall/Fields/Tannehill/Schach, and therefore an obvious expedient.

8. Claims 231-233, 238, 239, 244-250, 252, 253, 255, and 256 are rejected under 35 U.S.C.

103(a) as being unpatentable over Withnall as modified by Fields and Tannehill as applied to

5 claim 168 and 301 above, and further in view of Morales (US 5,872,589). The teachings of

Withnall as modified by Fields and Tannehill have been discussed above.

Re claims 231-233, 238, 239, 244-250, 252, 253, 255, and 256: Withnall/Fields/Tannehill have been discussed above but fails to teach or fairly suggest that the display unit comprises a personal planner/phone/pager.

10 Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7, line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of

Withnall/Fields/Tannehill in order to provide the user with the flexibility of selecting his/her

15 desired display unit that fits his/her needs, thus providing a more user-friendly system.

Furthermore, such modification would have been an obvious extension as taught by

Withnall/Fields/Tannehill, and therefore an obvious expedient.

20

Response to Arguments

9. As noted above, terminal disclaimer of US Patent 5,932,863 is accepted and entered. In doing so, Applicant overcame obviousness-type double patenting rejection issued by Examiner in previous Office Action.

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With respect to the rejection under 35 U.S.C. 103(a), Applicant argues (See page 13, under III.B thereafter) essentially that the cited references in combination fail to specifically teach or fairly suggest the subject matter disclosed in instant application.

Although Applicants' embodiment may be different from disclosures shown in these
5 references, it is Examiner's opinion that the cited references, in combination, teach the claimed invention of instant application. For example, claim 168 recites "A system for displaying programming material to a user, the system comprising: a printed advertisement having at least one machine recognizable feature; a feature recognition unit having associated therewith a means for recognizing said machine recognizable features and a means for transmitting a coded signal
10 in response to the recognition of said machine recognizable feature; an intelligent controller having associated therewith a means for accessing said programming material in response to receiving said coded signal; and a display unit for presenting said programming material." Other independent claims 256 and 259 recite similar methods.

The Withnall patent discloses a printed travel ticket having one machine recognizable
15 feature such as barcode; a feature recognition unit; and a portable handset displaying information to the users. Without borrowing the subject matter disclosed in the Fields patent, it is Examiner's view that travel information, which can be retrieved once barcode on the ticket has been read, can be broadly interpreted a programming material (see Withnall, col. 5, lines 14+) associated with the barcode. However, programming material disclosed in the Fields patent is
20 more similar to the programming material cited in instant application in that captured barcode triggers videodisc player to position itself at correct address location and read information (see abstract of Fields). It is also Examiner's opinion that such ticket often includes advertisement

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material (for instance, the subway ticket in Metropolitan Washington area imprinted with panda bears in National Zoo). Accordingly, incorporating advertisement material on fair tickets or other tickets (i.e., concert tickets, sports events) is widely used in real applications, and well within the ordinary skill in the art.

5 In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5
10 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Withnall and the secondary references to Fields are directed to a printed matter (i.e., tickets, textbooks, etc.) comprising an indicia, which is used for programming and further processing. Accordingly, it is Examiner's view that the motivations, which are within one ordinary skill in the art, to improve the primary reference to Withnall have
15 been provided.

Although double patenting rejection has been overcome, the claims are broadly recited such that the cited references, taken alone or in combination, teach the claimed invention.

Applicants' amendment and remarks describing these elements have been carefully studied and considered, but they are not persuasive. Therefore, Examiner has made this Office
20 Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
5 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
10 however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru
15 Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that
25 sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding
30 should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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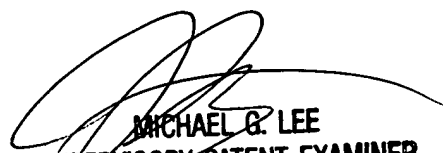


Ahshik Kim

Patent Examiner

Art Unit 2876

5 August 11, 2003



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800